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FACSIMILE COVER LETTER

To: Examiner Carlos Lugo - Art Unit 3676 (Telephone 571-272-7058)
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Company: USPTO

From: Taylor & Aust, P.C.

RE: U.S. Patent Application Serial No. 10/665,704
Title: PUSH-PUSH SLIDING COSMETIC CONTAINER
Our Ref: Case 14000/ITW0072.US

Comments: Transmitted herewith are:

Notice of Appeal -	1 page (2 copies)
Pre-Appeal Brief Request for Review -	5 pages

Total number of pages, including cover letter: 8

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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
Bella et al.) Group: 3676
Serial No.: 10/665,704)
Filed: September 19, 2003)
Title: PUSH-PUSH SLIDING COSMETIC) Examiner: Lugo, Carlos
CONTAINER)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal from the Examiner's decision dated February 15, 2006.

Claims 1, 4, 8-12 and 14-20 were pending and considered. Claims 1, 4, 8-12 and 14-20 were rejected in an Office Action designated as Final. The panel of Examiners is requested to review the legal and factual basis of the rejections for the reasons that follow.

Claims 1, 4, 8, 9, 12 and 18-20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over DE 29702278 (Chang et al.) in view of EP 982454 (Pryce-Hall).

Claims 10, 11 and 14-17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Chang et al. in view of Pryce-Hall as applied to claim 1, and further in view of JP 11270212 (Sasaki).

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For a detailed discussion of the teachings of the references, the Panel of Examiners is directed to pages 6-7 of the Amendment filed December 7, 2005.

With respect to claims 12 and 19, directed to a cosmetic container (claim 12) and a method for using a cosmetic container (claim 19), in the Final Office Action the Examiner responded to Applicants' argument found on pages 6-8 of the Amendment filed December 7, 2005. The Examiner stated, "... the recitation with respect to the manner in which an apparatus is intended to be employed does not impose any structural limitation upon the claimed apparatus, which differentiates it from a prior art reference disclosing the structural limitations of the claim." The Examiner went on to state, "... where there is physical identity between the subject matter of the claims and the prior art, the label given to the claimed subject matter does not distinguish the invention over the prior art."

Applicants respectfully request that the Panel consider the language of pending claims 12 and 19. It is submitted that the claims recite more than "the manner in which an apparatus is intended to be used" and do not merely provide a different "label given to the claimed subject matter". Claim 12 specifically recites a cosmetic container that has "a drawer defining at least one compartment for a cosmetic,..." Claim 19 recites a method for using a cosmetic container which includes, "providing a cosmetic in the drawer;" and "exposing the cosmetic contained in the drawer."

Applicants have specifically identified problems and needs surrounding the design of known cosmetic containers. For example, in paragraph [02] of the pending application, the Applicants identify that known cosmetic containers can be opened easily and unintentionally, accidentally spilling the content, which is a messy product. In paragraph [04] of the application the Applicants note that cosmetic containers often are small, holding only a small volume of material which is used only in small amounts. The cases for cosmetics are very thin, and designed to fit easily in purses, pockets and convenient carrying locations. Applicants further note that the nature of the container complicates designing latches for the container, as it is difficult to form a suitable latch that is easy to install and operate yet is secure when closed on a

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thin type of container frequently used for cosmetics. In paragraph [05] the Applicants note that a cosmetic container latch must operate in a small environment, both narrow and thin. Applicants further note in paragraph [05] of the application that containers for cosmetics and other consumables typically are not reused and are disposable. Therefore it is desirable that the container is inexpensive to manufacture, and the latch mechanism should not add significantly to the manufacturing cost of the container. Accordingly, there are very specific problems associated with small, disposable containers for cosmetics and the like. Applicants' invention addresses these problems.

In the Final Office Action, the Examiner suggests that it is mere design choice for one skilled in the relevant art to combine the references in the manner done by Applicants. If a latch were simply a latch, such might be the case. However, a latch for a cosmetic container has specific desirable features that are different from desirable features for latches on desk drawers, safety latches on ceiling access panels and earthquake-proof doors. Desirably, a latch for a cosmetic case is inexpensive for use in a disposable item, it is operable in a very small environment, both narrow and thin, yet it remains secure to prevent spillage of a very messy content. It is respectfully submitted that a locking and unlocking control device for a drawer of a desk (Chang et al.), a safety latch for a ceiling access panel (Pryce-Hall) and an earthquake proof door (Sasaki) do not meet the desirable features of a cosmetics case latch, and to combine features of such devices in a cosmetics case is not obvious.

In the Amendment filed on December 7, 2005, at page 8 Applicants noted that there is no suggestion in the prior art which would lead one to combine the features of the individual references in the way the Examiner has combined them. The Examiner has acknowledged this, but argues that "a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill without any specific hint or suggestion in a particular reference."

With respect to claims 12 and 19, which specifically recite a cosmetic container (claim 12) and a method for using a cosmetic container (claim 19), Applicants submit that not only is

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the combination of references not obvious to one skilled in the art, Applicants further submit that one skilled in the art of cosmetic container design or use would not look to such heavyweight structures as a desk drawer (Chang et al.), a safety latch mechanism for a ceiling access panel (Pryce-Hall) or an earthquake proof door apparatus (Sasaki) for features relevant to the very small, very lightweight and inexpensive latch required for a cosmetic case. In fact, common sense would direct one skilled in the art away from the heavy weight, large and expensive designs of those items. If one skilled in the art would not look to such designs for specific features, clearly one skilled in the art of cosmetic container design and use would not think to combine disjointed features from such references without any direction in the prior art to do so. In seeking to provide and use an improved cosmetic container, Applicants respectfully suggest one cannot be expected to look to the designs of Chang et al., Pryce-Hall and Sasaki for features, let alone for a combination of those features.

To select features from objects as different as a desk drawer (Chang et al.), a safety latch mechanism for a ceiling access panel (Pryce-Hall) and an earthquake proof door apparatus (Sasaki), and then to argue the combination is obvious without a connecting teaching is clearly a hind-sight approach. With the Applicants' invention as a guide, the Examiner has found separate, individual features of the invention, but without clear guidance in any reference to connect the features. It is respectfully submitted that an unstructured combination of teachings gathered only with the guidance of Applicants' invention is insufficient to render obvious the invention of claims 1, 12 or 19.

Claims 4 and 8-11 dependent from claim 1, claims 14-18 depend from claim 12 and claim 20 depends from claim 19. Applicants submit all dependent claims should be allowed together with the independent claims from which they depend.

For the foregoing reasons, Applicants submit that no combination of the cited references teaches, discloses or suggests the subject matter of the pending claims. The review panel is requested to remove all rejections and indicate the allowance of all pending claims. Consideration and allowance are respectfully requested.

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In the event Applicants have overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally petition therefor and authorizes that any charges be made to Deposit Account No. 20-0095, TAYLOR & AUST, P.C.

In the event that there are any issues that can be expedited by telephone conference, the Examiner is invited to telephone **Paul Donovan** at (847) 657-4075.

Respectfully submitted,



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RWC/dc

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I hereby certify that this correspondence is being transmitted via facsimile to the U.S. Patent and Trademark Office, on: May 15, 2006.

Raymond W. Campbell, Reg. No. 29,902
Name of Registered Representative


Signature

May 15 2006
Date